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IN THE  
Supreme Court of the United States

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October Term, 1971

No. 70-314

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BRUNETTE MACHINE WORKS LTD.,  
*Petitioner,*

v.

KOCKUM INDUSTRIES, INC.  
*Respondent.*

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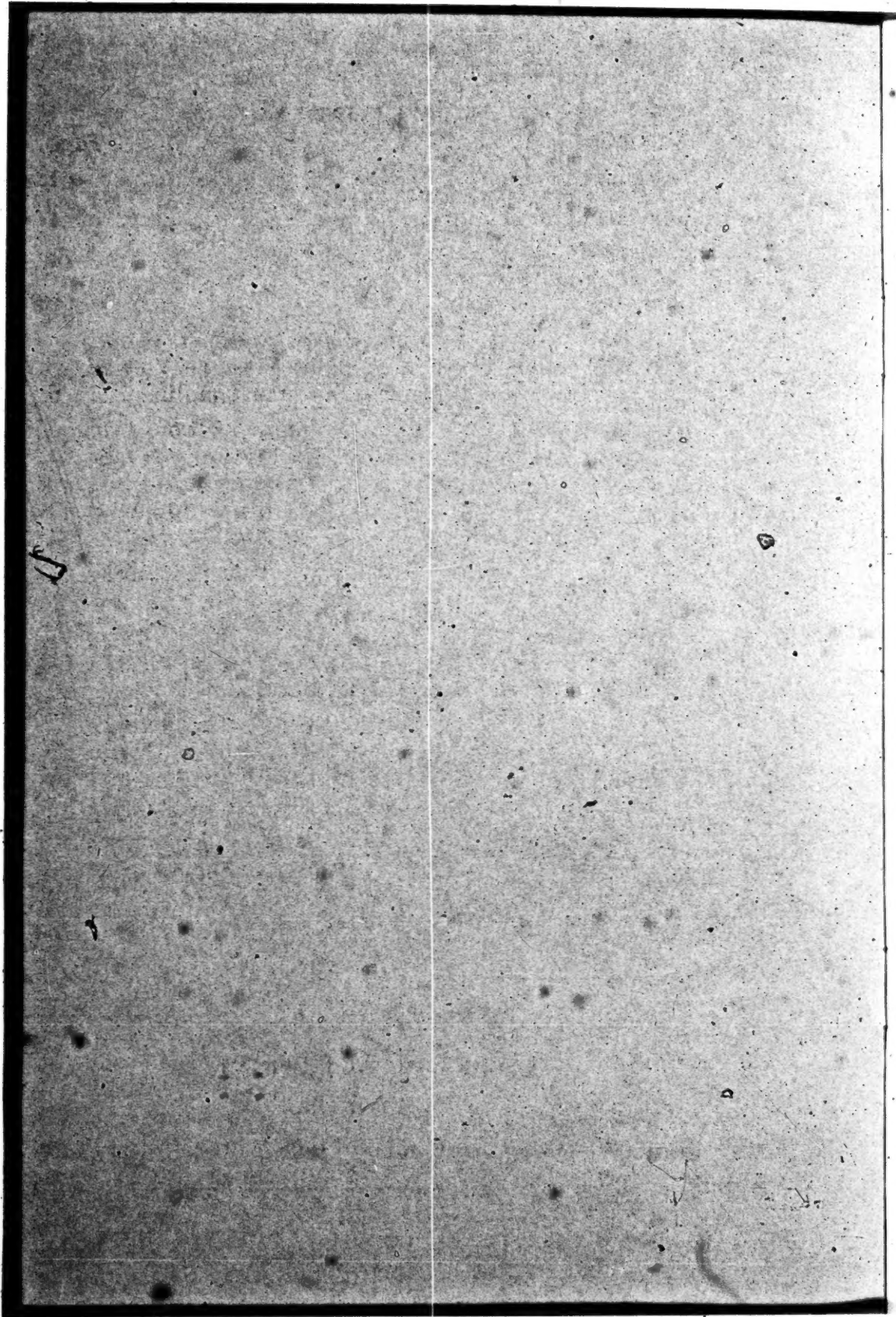
**BRIEF OF RESPONDENT**  
IN ANSWER TO A WRIT OF CERTIORARI TO  
THE UNITED STATES COURT OF APPEALS  
FOR THE NINTH CIRCUIT

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**BRIEF OF RESPONDENT**  
IN ANSWER TO A WRIT OF CERTIORARI TO  
THE UNITED STATES COURT OF APPEALS  
FOR THE NINTH CIRCUIT

---

**QUESTIONS PRESENTED**

Whether an alien infringer of a United States patent, neither residing nor having a regular and established place of business in any federal judicial district, may be sued in a district where *in personam* jurisdiction can be obtained pursuant to 28 U.S.C. § 1391(d).

**STATEMENT OF THE CASE**

Respondent Kockum Industries, Inc. (hereinafter "KOCKUM"), an Alabama corporation, sued petitioner, Brunette Machine Works, Ltd. (hereinafter "BRUNETTE"), a British Columbia, Canada corporation, in Oregon for infringement of United States Letters Patent

Nos. 2,775,274 and 2,855,010. Jurisdiction and venue in the District Court were based on 28 U.S.C. §§ 1338(a) and 1391(d), O.R.S. § 14.035, and Rules 4(e) and (i), Fed. R. Civ. Proc. Upon the motion of BRUNETTE, the suit was dismissed on the ground that BRUNETTE neither resided nor had a regular and established place of business in the Oregon district and that, therefore, the requirements of 28 U.S.C. § 1400(b) were not met (A. 18).

The inventions defined by the patents in suit are machines for mechanically removing bark from logs. These machines are commonly called "barkers" or "debarkers".

In 1963, BRUNETTE and Salem Equipment, Inc. (hereinafter "SALEM"), an Oregon corporation, entered into a written technology interchange agreement (A. 8-16) and in accordance with the terms of this agreement, BRUNETTE and SALEM, in exchange for the payment of royalties by one to the other, agreed to: (1) give advice and assistance to the other in the establishment and manufacturing, and installation of machinery and equipment utilized in the sawmill and logging industry; (2) furnish the other with technicians of such skill and in such number as to fulfill their respective responsibilities under the agreement; and (3) make available to the other full and complete technical information relative to the manufacture of the products covered by the agreement. This agreement has not been modified and is still in full force and effect, and royalties have been and are being paid by SALEM to BRUNETTE, and vice versa (A. 4-5).

In accordance with the agreement, BRUNETTE has supplied SALEM with complete technical assistance and information including; all blueprints for the manufacture



of "Brunette debarkers", visits of BRUNETTE personnel to SALEM'S principal place of business in Oregon, and telephone calls back and forth between BRUNETTE and SALEM personnel (A. 4,5). These debarkers are advertised in Oregon and elsewhere in the United States as "Salem-Brunette debarkers", (A. 5).

The first infringing "Salem-Brunette debarker" manufactured in the United States by SALEM under the agreement was installed in the plant of an Oregon customer (A. 5). This first debarker included ring and tool arms manufactured by BRUNETTE in Canada (A. 5). Several other infringing "Salem-Brunette debarkers" have subsequently been manufactured by SALEM in Oregon and sold in Oregon and elsewhere in the United States (A. 5).

Prior to the SALEM-BRUNETTE agreement, BRUNETTE had entered into a similar agreement with Carthage Machine Company, Inc., of Carthage, New York (hereinafter "CARTHAGE") to manufacture infringing "Brunette debarkers" (A. 5-6). With BRUNETTE'S approval, SALEM and CARTHAGE have made an agreement whereby SALEM can sell infringing "Salem-Brunette debarkers" throughout the United States upon payment of royalties to CARTHAGE as well as to BRUNETTE on sales outside of the western United States (A. 5-6). CARTHAGE has not manufactured debarkers under the CARTHAGE-BRUNETTE agreement but rather has sold infringing "Brunette debarkers" manufactured by BRUNETTE in Canada and advertised in the United States as "Carthage-Brunette debarkers" (A. 6). One of the infringing "Carthage-Brunette debarkers" was demonstrated at a 1967 machinery exposition in Louisiana, with a BRU-

NETTE vice president assisting in the demonstration (A. 6).

BRUNETTE through the exportation of infringing "Brunette debarkers" to CARTHAGE for sale in the United States, has infringed the patents in suit and induced CARTHAGE to infringe the patents in suit (A. 6-7). BRUNETTE through its business dealings and contractual arrangements with SALEM and CARTHAGE relating to infringing "Brunette debarkers", has contributorily infringed and induced SALEM and CARTHAGE to infringe the patents in suit (A. 4-7) and has benefitted financially and continues to benefit financially from such contractual arrangements (A. 4 and 7). BRUNETTE has transacted business in the State of Oregon and continues to transact business in Oregon with regard to and as a consequence of the contractual arrangements with SALEM relating to infringing "Brunette debarkers" (A. 6).

### SUMMARY OF ARGUMENT

When an alien performs acts within the United States that create a federal cause of action and that provide sufficient contacts within the United States to subject the alien to the *in personem* jurisdiction of a United States federal court, federal venue provisions should not be applied so restrictively as to effectively immunize the alien from liability.

In the present case, the alien, Brunette Machine Works Ltd., has induced a United States national to infringe the respondent's patent and in committing the acts constituting the inducement has violated United States patent law, 35 U.S.C.A. § 271 (b), and has subjected itself to the *in personem* jurisdiction in the federal judicial district encom-

passing the State of Oregon. BRUNETTE does not, however, reside or have a regular and established place of business in any federal judicial district. Therefore, 28 U.S.C. § 1400(b) does not enable any court to adjudicate BRUNETTE'S liability for patent infringement. Unless 28 U.S.C. § 1391(d) applies in this case, BRUNETTE will have successfully avoided the application of United States federal law to its activities within the United States.

All cases, excepting one, that heretofore considered venue in a patent infringement action against an alien have concluded that venue is proper wherever the alien could be found. These cases have been decided in interpreting 28 U.S.C. § 1391(d) and 1400(b) and the predecessor statutes to § 1400(b), there being no predecessor statute to § 1391(d). The one exception is the seventh circuit decision of *Coulter Electronics Inc. v. A. B. Lars Ljungberg & Co.*, 1967, 376 F.2d 743, cert. denied, 389 U.S. 859.

The *Coulter* decision concluded that the Court's decisions of *Fourco Glass Co. v. Transmirra Products Corp.*, 1957, 353 U.S. 222, and *Stonite Products Co. v. Melvin Lloyd Co.*, 1942, 315 U.S. 561, holding that 28 U.S.C. § 1400(b) and its predecessor statute were the exclusive venue statutes applicable to suits involving domestic patent infringers, precluded application of § 1391(d) to alien patent infringers. The *Fourco* decision, however, emphasized the importance of looking to Congressional intent as an aid in determining the applicability of the codified venue provisions of the 1948 Judicial Code.

Looking to the Reviser's notes to § 1391(d), one is referred to two cases supporting the venue rule enunciated in § 1391(d) that "an alien may be sued in any district."

The first case cited, *Sandusky Foundry & Machine Co. v. De Lavaud*, 1918, D.C. Ohio, 251 F. 631, decided that an alien patent infringer could be sued in any district where *in personem* jurisdiction could be obtained. The second case cited, *Keating v. Pennsylvania Co.*, 1917, D.C. Ohio, 245 F. 155, decided that a non-patent action instituted in a state court by an alien against a corporation not domiciled in the state could be removed inasmuch as an alien could be sued in any district and hence the action could have been instituted against the alien in the federal judicial district encompassing that State. The Reviser's selection of both a patent and a non-patent case to illustrate the application of § 1391(d) evidences Congressional intent that alien patent infringers, as before enactment of the 1948 Judicial Code, may be sued in any district where *in personem* jurisdiction may be obtained.

## ARGUMENT

### I.

#### **On a Motion to Dismiss for Improper Venue, Allegations in the Complaint Must Be Viewed in a Light Most Favorable to the Plaintiff**

In the present suit, the allegations contained in the Complaint filed on behalf of KOCKUM have not been controverted in any pleading and no affidavit was filed in support of BRUNETTE'S Motion to Dismiss. Therefore, these allegations must be considered true, *U.S. v. New Wrinkle*, 1952, 342 U.S. 371; *Collins v. Hardyman*, 1951, 341 U.S. 651, for purposes of this appeal.

The allegations contained in the Complaint clearly establish that BRUNETTE has directly infringed the patents in suit by exporting infringing machines to CARTHAGE for sale in the United States and by demonstrating an

infringing machine in Louisiana for the purpose of inducing purchase orders for such machines. 35 U.S.C.A. 271 (a); *Union Asbestos & Rubber Co. v. Evans Products Co.*, 7th Cir., 1964, 328 F.2d 949. The allegations also establish that BRUNETTE has induced SALEM and CARTHAGE to infringe the patents in suit by supplying them with manufacturing drawings and technical personnel in exchange for royalties, and by approving the advertisement of these infringing debarkers in the United States as "Salem-Brunette debarkers" and "Carthage-Brunette debarkers". 35 U.S.C.A. 271(b); *Shumaker v. Gem Mfg. Co.*, 7th Cir., 1962, 311 F.2d 273; and *Weyerhaeuser Timber Co. v. Bostitch Inc.*, D.R.I., 1959, 178 F.Supp. 757.

Furthermore, by initially supplying SALEM with the ring and tool arms for the first infringing machine manufactured by SALEM, BRUNETTE has supplied SALEM with components of the infringing machine that are especially made for use in the infringing machine and that are not a staple article of commerce suitable for substantial noninfringing use. BRUNETTE, therefore, has contributorily infringed the patents in suit. 35 U.S.C.A. 271 (c); *Stearns v. Tinker & Razor*, 9th Cir., 1958, 252 F.2d 589, cert. den. 350 U.S. 830; and *Electric Pipe Line, Inc. v. Fluid Systems, Inc.*, 2nd Cir., 1956, 231 F.2d 370.

## II.

### **Brunette, Having Taken Voluntary Actions Calculated to Have an Effect in Oregon, May Be Sued in the Oregon District Without Violating the Dictates of Fundamental Fairness Required for Due Process**

The contacts which BRUNETTE has had with SALEM in the Oregon District are sufficient to subject BRUNETTE



to the *in personem* jurisdiction of the District Court pursuant to the Oregon long-arm statute, O.R.S. § 14.035, under the doctrine of *International Shoe Co. v. State of Washington*, 1945, 326 U.S. 310; *McGee v. International Life Insurance Co.*, 1957, 355 U.S. 220; and *Hanson v. Denckla*, 1958, 357 U.S. 235.

BRUNETTE entered into the agreement with SALEM to realize the pecuniary benefits of royalties from SALEM'S operations which are headquartered in Oregon (A-12-13). BRUNETTE retained significant power of supervision and verification of SALEM'S records, including the right to receive accurate accounts of sales made by SALEM and to audit SALEM'S books and operations (A-13). BRUNETTE must communicate to SALEM all technical information developed subsequent to the date of the agreement and SALEM is to respond in like manner (A-12) and the agreement is to be interpreted under Oregon law (A-14).

The ties by which BRUNETTE'S interests are promoted in Oregon are concretely embodied in a continuous stream of business communications, remittance of royalties, technical assistance and other contacts which the agreement encompasses. Through these series of continuing ties, BRUNETTE has set in motion substantial operations in Oregon and availed itself of the benefits therefrom. These ties are sufficient to subject BRUNETTE to the jurisdiction of the District Court within the rationale of the decisions in *International Shoe Co.*, *supra*; *McGee*, *supra*, and *Hanson*, *supra*.

Furthermore, the infringements of the patents in suit by BRUNETTE constitute tortious acts committed within the Oregon District as a direct result of these continuing ties



with the Oregon forum. Such acts also are sufficient to subject BRUNETTE to the jurisdiction of the District Court within the rationale of *International Shoe Co.*, *supra*; *McGee*, *supra*; and *Hanson*, *supra*.

### III.

#### **Brunette Is Subject to the *In Personem* Jurisdiction of the District Court Under the Oregon Long Arm Statute**

The relevant portions of the Oregon long arm statute, O.R.S. 14.035, read as follows:

"Section 1. (1) Any person, firm or corporation whether or not a citizen or a resident of this state, who, in person or through an agent, does any of the actions enumerated in this subsection thereby submits such person to the jurisdiction of the courts of this state, as to any cause of action or suit or proceeding arising from any of the following:

"(a) The transaction of any business within this state;

"(b) The commission of a tortious act within this state:

"(4) Nothing contained in this section limits or affects the right to serve any person in any other manner now or hereafter provided by law."

This statute is applicable to any foreign corporation that transacts any business within the state or commits a tortious act within the state, and service of process under O.R.S. 14.035 may be effected under Rules 4(e) and (i), F.R.Civ.P. *Hiersche v. Seamless Rubber Co.*, D. Ore., 1963, 225 F.Supp. 682; *Hicks v. Crane Co.*, D. Ore., 1964, 235 F.Supp. 609; *David v. London Shirt Co.*, D. Ore., 1966, 259 F.Supp. 848.

## IV.

**Venue Is Properly Laid in the Oregon District  
Pursuant to 28 U.S.C.A. §1391(d)**

Subject to being amenable to service of process, BRUNETTE, as an alien corporation and an infringer of the patents in suit, can be sued in any district pursuant to 28 U.S.C.A. § 1391(d) which states:

“An alien may be sued in any district.”

**A. *The Enactment of §1391(d) Codified the Law That an Alien Infringer of a United States Patent May Be Sued in Any District.***

The cases prior to 1948 under the Act of March 3, 1897, c.395, 29 Stat. 695, and the 1911 Judicial Code derived therefrom, established that Section 48 of the 1911 Judicial Code [28 U.S.C.A. §109 (1940 ed.)], limiting venue over patent infringers, did not apply to alien defendants. *Re Hohorst*, 1893, 150 U.S. 653; *Barrow Steamship Co. v. Kane*, 1898, 170 U.S. 100; *United Shoe Machinery Co. v. Duplessis Independent Shoe Machinery Co., Ltd.*, C.C. Mass., 1904; 153 Fed. 930; *Sandusky Foundry & Machine Co. v. De Lavaud*, N.D. Ohio, 1918, 251 Fed. 631; *Keating v. Pennsylvania Co.*, N.D. Ohio, 1917, 245 Fed. 155; and *Keller v. American Sales Book Co.*, W.D. N.Y., 1936, 16 F.Supp. 189. As stated in *Keller v. American Sales Book Co.*, *supra*, at 190, in reference to Section 48 of the 1911 Judicial Code:

“It is clear from the language of the section and from numerous authorities that section 48, *supra*, has no application to a foreign (alien) corporation which has no place of business within the District.”

The 1948 Judicial Code codified the prior law and § 1391(d), 28 U.S.C.A., thereof, specifically codified the

prior case law that aliens, including alien infringers of a United States patent, may be sued in any district. The Reviser's Note to § 1391(d), 28 U.S.C.A., p. 62, states:

"Subsection (d) of this section is added to give statutory recognition to the weight of authority concerning a rule of venue as to which there has been a sharp conflict of decision. See (*Sandusky Foundry and Machine Co. v. De Lavaud*, 1918, D.C. Ohio, 251 F. 631, 632, and cases cited. See also *Keating v. Pennsylvania Co.*, 1917, D.C. Ohio, 245 F. 155 and cases cited)."

In *Sandusky Foundry and Machine Co. v. De Lavaud*, *supra*, the court held that venue in a patent infringement suit against a defendant alien attached against the alien in any district in which process could be served upon the alien, notwithstanding the special patent venue statute (Section 48 of the 1911 Judicial Code) limiting venue in patent infringement cases to the district wherein the defendant is an inhabitant or has committed acts of infringement and has a regular and established place of business. The Court in *Sandusky* at p. 632-633, stated:

"The defendants who have appeared are aliens. It seems to be settled law that they are not inhabitants of any district, and may be sued in any district within which process can be served on them. It was so held under what is now Section 48 of the Judicial Code (Act. March 3, 1911, c.231, 36 Stat. 1100 [Comp. St. 1916 §§ 1024, 1030]) in *United [Shoe Machinery] Company v. Duplessis Company* (C.C.) 133 F. 930. Such is said to be the law in *Walker on Patents* (5th Ed.) § 389. The same holding has been repeatedly made under section 51 of the Judicial Code (Comp. St. 1916, § 1033) as applied to causes of action other than suits arising under the patent laws. In *re Horst*, 150 U.S. 653, 14 S.Ct. 221, 37 L.Ed. 1211; *Barrow Steamship Co. v. Kane*, 170 U.S. 100, 18 S.Ct. 526, 42 L.Ed. 964; *Wind River Lumber Co. v. Frankfort Marine Ins. Co.*, 196 F. 340, 116 C.C.A. 160;

*Keating v. Pennsylvania Co.* (D.C.) 245 F. 155. The reasoning applied equally to both classes of cases against alien defendants."

From the Reviser's Note it is clear that the law has been, and under § 1391(d) continues to be, that special patent venue statutes are not applicable to alien patent infringers and that venue is proper over alien patent infringers in any district wherein the alien is amenable to service of process.

The better-reasoned cases since enactment of the 1948 Judicial Code have uniformly held that § 1391(d) is applicable to alien infringers of a United States patent. *Chas. Pfizer & Co. v. Laboratori Pro-Ter Prodotti Therapeutici*, S.D. N.Y., 1967, 278 F.Supp. 148; *Olin Mathieson Chemical Corp. v. Molins Organizations, Ltd.*, E. D. Va., 1966, 261 F.Supp. 436; *Japan Gas Lighter Association v. Ronson Corp.*, D.N.J., 1966, 257 F.Supp. 219; *SCM Corp. v. Brother International Corp.*, S.D. N.Y., 1970, 316 F.Supp. 1328; *Deering Milliken Research Corp. v. Stahlecker*, D.S.C. 1969, 166 U.S. P.Q. 321; and *Deering Milliken Research Corp. v. Vecchioni*, E.D. Va. 1970, 168 U.S. P.Q. 59. In contrast to the holdings of these cases, the Seventh Circuit in *Coulter Electronics, Inc. v. A. B. Lars Ljunberg & Co.*, 1967, 376 F.2d 743, cert. den. 389 U.S. 859, 99 S.Ct. 103, 198 L.Ed.2d 124, held that § 1400(b), 28 U.S.C.A., is the sole and exclusive provision controlling venue in patent infringement actions and is not to be supplemented by § 1391(d), citing *Fourco Glass Co. v. Transmirra Products Corp.*, 1957, 353 U.S. 222, for its holding that § 1400(b) is not supplemented by § 1391(c).

The emphasis placed by the Court in *Fourco* on the Reviser's Notes and the preceding judicial holdings, however, supports the conclusion that the provisions of § 1400 (b) were not intended to be exclusive in suit against aliens

but were to be supplemented by § 1391(d). The Court in holding that § 1400(b)'s requirements were exclusive in a suit against a *domestic* corporation, based its decision on the fact that Congress re-enacted the subject matter of § 1400(b) in 1948 with no expression of intent (either in the Reviser's Notes or the text) that § 1400(b) should be supplemented by § 1391(c). The prior decision of *Stonite Prods. Co. v. Melvin Lloyd Co.*, 1942, 315 U.S. 561, clearly held that § 1400(b)'s predecessor [Section 48 of the 1911 Judicial Code] was the sole provision governing venue in a suit against a domestic corporation and was exclusive with respect to § 1392(a)'s predecessor [Section 52 of the 1911 Judicial Code, 28 U.S.C. (1940 ed.) § 113]. The *Fourco* decision was expressly based on the Court's conclusion that § 1400(b) enacted its predecessor provision [Section 48 of the 1911 Judicial Code] without substantive change, 353 U.S. at 227, 77 S.Ct. at 787, and that venue practice under Section 48 was clearly narrower with regard to corporate residence than that permissible under § 1391(c).

The prevailing venue practice under Section 48 of the 1911 Judicial Code was equally clear that alien corporations could be sued in any district in patent infringement actions and that Section 48 was not applicable to alien infringers. Furthermore, Congressional intent to give statutory recognition to established alien venue practice in patent infringement actions is clearly expressed by the Reviser's Note citation to the *Sandusky* case relative to § 1391(d). As noted by the court in the *Pfizer* case on motion to reconsider its decision holding that venue was proper over the alien defendant before that court:

"On the same day that this Court's decision was handed down, the Supreme Court denied certiorari in



Coulter Elec. Inc. v. A. B. Lars Ljungberg & Co., 389 U.S. 859, 99 S.Ct. 103, 19 L.Ed.2d 124 (1967). In Coulter, the Seventh Circuit relying principally on the Supreme Court's decision in Fourco Glass v. Transmirra Prods. Corp., 353 U.S. 333, 77 S.Ct. 787, 1 L.Ed. 2d 786 (1957) and Stonite Prods. Co. v. Melvin Lloyd Co. 315 U.S. 561, 62 S.Ct. 780, 86 L.Ed. 1026 (1942), held that a suit against an alien infringer will not permit an exception to the exclusivity of the patent venue statute, and that in such a suit §1391(d) has no applicability. 376 F.2d 743 (7th Cir., 1967). *It does not appear, however, that either the Seventh Circuit or the Supreme Court had directed to their attention, or considered, the legislative history of §1391(d), as reflected in the Reviser's Note, which distinguishes it from §1391(c) and shows that §1391(d), unlike §1391(c), was intended to supplement §1400(b).*" (Emphasis added) p. 154.

**B. Sound Policy Supports the Conclusion That Venue in Suits Against Aliens Is Not Limited to the Districts Mentioned in 28 U.S.C. § 1400(b).**

Policy dictates that alien patent infringers may be sued in any district wherein they are amenable to service of process. Otherwise, it might be possible that such aliens could not be sued in any United States court. The first ground for establishing venue under 28 U.S.C. § 1400(b) is never available because aliens are not inhabitants of any district. The second ground might not be available, and in the present case is not available, because the alien BRUNETTE, has no regular and established place of business in any district. Even though an alien's conduct and contacts in various districts of the United States may be extensive, it is common knowledge that many alien businessmen neither reside nor maintain regular and established places of business in any federal district, but rather prefer to conduct their business through agents as in the Pfizer



case, *supra*, or by subsidiaries as in the *Olin Mathieson* case, *supra*, or by distributors as in the *Coulter* case, *supra*, or by licensing a domestic corporation to conduct the alien's business within the United States as in the *Japan Gas-Lighter* case, *supra*, and as in the present case. There is no indication of a Congressional intent to permit aliens to infringe or actively induce infringement of United States patents while transacting sufficient business to subject themselves to service of process without concomitantly requiring them to bear the consequences in the district wherein such business is transacted. On the contrary, equity demands that United States citizens should be able to enforce their United States patents against aliens who have infringed or induced infringement in the United States and who are directly benefiting from the result of such infringement.

Where, as in the present case, the alien's most significant infringing activity in the United States is the inducement of others to commit direct infringement, proceedings before the Tariff Commission under Section 337 of the Tariff Act of 1930, 19 U.S.C. 1337, c. 497, 46 Stat. 703, are inapplicable. In appropriate cases, Section 337 only enables the Tariff Commission to prospectively exclude articles or goods from entry into the United States. Furthermore, since at least 1944, there does not appear to have been any case successfully concluded before the Tariff Commission pursuant to Section 337.

Finally, if an alternative forum exists within which suit could be instituted against an alien infringer, 28 U.S.C. § 1404 provides an appropriate means by which the choice of an inconvenient forum can be remedied. The applica-

tion of statutory venue provisions to enable the federal courts to adjudicate the liability of an alien infringer's violation of United States patent laws does not constitute a disadvantage to the alien but rather places the alien on the same footing as United States nationals. This result is essentially no different as regards aliens than that provided by 35 U.S.C. §§ 146 and 291 which subject aliens to suit in the District of Columbia in the context of patent interferences.

### CONCLUSION

BRUNETTE, an alien corporation, may be sued in any district wherein *in personam* jurisdiction can be obtained. Where, as here, the alien patent infringer neither resides nor has a regular and established place of business in any federal judicial district venue is proper wherever the alien is amenable to service of process pursuant to 28 U.S.C. § 1391(d).

Respectfully submitted,

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## APPENDIX A\*

APPENDIX OF STATUTES AND RULES CITED  
APPENDIX OF RULES AND STATUTES

## I.

## Federal Rules of Civil Procedure

**Rule 4(e)**

Same: Service Upon Party Not Inhabitant of or Found Within State. Whenever a statute of the United States or an order of court thereunder or of an order in lieu of summons, or of a notice or of an order in lieu of summons upon a party not an inhabitant of or found within the state in which the district court is held, service may be made under the circumstances and in the manner prescribed by the statute or order, or, if there is no provision therein prescribing the manner of service, in a manner stated in this rule. Whenever a statute or rule of court of the state in which the district court is held provides (1) for service of a summons, or of a notice, or of an order in lieu of summons upon a party not an inhabitant of or found within the state, or (2) for service upon or notice to him to appear and respond or defend in an action by reason of the attachment or garnishment or similar seizure of his property located within the state, service may in either case be made under the circumstances and in the manner prescribed in the statute or rule.

**Rule 4(i)**

Alternative Provisions for Service in a Foreign Country.

(1) Manner. When the federal or state law referred to in subdivision (e) of this rule authorizes service upon a party not an inhabitant of or found within the state in which the district court is held, and service is to be effected upon the party in a foreign country, it is also sufficient if service of the summons and complaint is made: (A) in the manner prescribed by the law of the foreign country for service in that country in an action in any of its courts of general jurisdiction;

or (B) as directed by the foreign authority in response to a letter rotatory, when service in either case is reasonably calculated to give actual notice; or (C) upon an individual, by delivery to him personally, and upon a corporation or partnership or association, by delivery to an officer, a managing or general agent, or (D) by any form of mail, requiring a signed receipt, to be addressed and dispatched by the clerk of the court to the party to be served; or (E) as directed by order of the court. Service under (C) or (E) above may be made by any person who is not a party and is not less than 18 years of age or who is designated by order of the district court or by the foreign court. On request, the clerk shall deliver the summons to the plaintiff for transmission to the person or the foreign court or officer who will make the service.

(2) Return. Proof of service may be made as prescribed by subdivision (g) of this rule, or by the law of the foreign country, or by order of the court. When service is made pursuant to subparagraph (1) (D) of this subdivision, proof of service shall include a receipt signed by the addressee or other evidence of delivery to the addressee satisfactory to the court.

## II.

### 28 U.S.C.A. (1948 ed.)

#### §1338(a)

The district courts shall have original jurisdiction of any civil action arising under any Act of Congress relating to patents, copyrights and trademarks. Such jurisdiction shall be exclusive of the courts of the states in patent and copyright cases.

The district courts shall have original jurisdiction of any civil action asserting a claim of unfair competition when joined with a substantial and related claim under the copyright, patent or trade-mark laws.

#### §1391(a)

A civil action wherein jurisdiction is founded only on diversity of citizenship may, except as otherwise provided by law, be brought only in the judicial dis-

trict where all plaintiffs or all defendants reside, or in which the claim arose.

**§1391(c)**

A corporation may be sued in any judicial district in which it is incorporated or licensed to do business or is doing business, and such judicial district shall be regarded as the residence of such corporation for venue purposes.

**§1391(d)**

An alien may be sued in any district.

**§1400(b)**

Any civil action for patent infringement may be brought in the judicial district where the defendant resides, or where the defendant has committed acts of infringement and has a regular and established place of business.

**§1404(a)**

For the convenience of parties and witnesses, in the interest of justice, a district court may transfer any civil action to any other district or division where it might have been brought.

**III.**

**Judicial Code of 1911  
[28 U.S.C.A. (1940 ed.)]**

**Section 48 [28 U.S.C.A. §109]**

In suits brought for the infringement of letters patent the district courts of the United States shall have jurisdiction, in law or in equity, in the district of which the defendant is an inhabitant, or in any district in which the defendant, whether a person, partnership, or corporation, shall have committed acts of infringement and have a regular and established place of business. If such suit is brought in a district of which the defendant is not an inhabitant, but in which such defendant has a regular and established place of business, service of process, summons, or subpoena upon



the defendant may be made by service upon the agent or agents engaged in conducting such business in the district in which suit is brought.

**Section 51 [28 U.S.C.A. §112]**

• • • except as provided in sections 113-118 of this title, no civil suit shall be brought in any district court against any person by any original process or proceeding in any other district than that whereof he is an inhabitant; but where the jurisdiction is founded only on the fact that the action is between citizens of the different states, suit shall be brought only in the district of the residence of either the plaintiff or the defendant; • • •

**Section 52 [28 U.S.C.A. §113]**

When a State contains more than one district, every suit, not of a local nature, in the district court thereof, against a single defendant, inhabitant of such State, must be brought in the district where he resides; but if there are two or more defendants residing in different districts of the State, it may be brought in either district, and a duplicate writ may be issued against the defendants, directed to the marshal of any other district in which any defendant resides. The clerk issuing the duplicate writ shall indorse thereon that it is a true copy of a writ sued out of the court of the proper district; and such original and duplicate writs, when executed and returned into the office from which they issue, shall constitute and be proceeded on as one suit; and upon any judgment or decree rendered therein, execution may be issued, directed to the marshal of any district in the same State.

**IV.**

**O.R.S. §14.035**

**[Oregon Laws, 1963, Chapt. 352]**

Section 1. (1) Any person, firm or corporation whether or not a citizen or a resident of this state, who, in person or through an agent, does any of the actions enumerated in this subsection thereby submits such person and, if an individual, his personal representative



to the jurisdiction of the courts of this state, as to any cause of action or suit or proceeding arising from any of the following:

(a) The transaction of any business within this state;

(b) The commission of a tortious act within this state)

(c) The ownership, use or possession of any real estate situated in this state;

(d) Contracting to insure any person, property or risk located within this state at the time of contracting.

(2) Service of summons on any person who is subject to the jurisdiction of the courts of this state, as provided in this section, may be made by personally serving the summons and copy of the complaint, upon the defendant outside this state, in the manner provided in ORS 15-110. Such service shall have the same force and effect as though summons had been personally served within this state.

(3) Only causes of action or suit or proceedings arising from acts enumerated in this section may be asserted against a defendant in an action or suit or proceeding in which jurisdiction over such defendant is based upon this section.

(4) Nothing contained in this section limits or affects the right to serve any person in any other manner now or hereafter provided by law.

## V.

### 35 U.S.C.A. (1952 ed.)

#### §146

Any party to an interference dissatisfied with the decision of the board of patent interferences on the question of priority, may have remedy by civil action, if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints or as provided in section 141 of this title, unless he has appealed to the United States Court of Customs

and Patent Appeals, and such appeal is pending or has been decided. In such suits the record in the Patent Office shall be admitted on motion of either party upon the terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court imposes, without prejudice to the right of the parties to take further testimony. The testimony and exhibits of the record in the Patent Office when admitted shall have the same effect as if originally taken and produced in the suit.

Such suit may be instituted against the party in interest as shown by the records of the Patent Office at the time of the decision complained of, but any party in interest may become a party to the action. If there be adverse parties residing in a plurality of districts not embraced within the same state, or an adverse party residing in a foreign country, the United States District Court for the District of Columbia shall have jurisdiction and may issue summons against the adverse parties directed to the marshal of any district in which any adverse party resides. Summons against adverse parties residing in foreign countries may be served by publication or otherwise as the court directs. The Commissioner shall not be a necessary party but he shall be notified of the filing of the suit by the clerk of the court in which it is filed and shall have the right to intervene. Judgment of the court in favor of the right of an applicant to a patent shall authorize the Commissioner to issue such patent on the filing in the Patent Office of a certified copy of the judgment and on compliance with the requirements of law.

## §291

The owner of an interfering patent may have relief against the owner of another by civil action, and the court may adjudge the question of the validity of any of the interfering patents, in whole or in part. The provisions of the second paragraph of section 146 of this title shall apply to actions brought under this section.

§271

(a) Except as otherwise provided in this title, whoever without authority makes, uses or sells any patented invention, within the United States during the term of the patent therefor, infringes the patent.

(b) Whoever actively induces infringement of a patent shall be liable as an infringer.

(c) Whoever sells a component of a patented machine, manufacture, combination or composition, or a material or apparatus for use in practicing a patented process, constituting a material part of the invention, knowing the same to be especially made or especially adapted for use in an infringement of such patent, and not a staple article or commodity of commerce suitable for substantial noninfringing use, shall be liable as a contributory infringer.

(d) No patent owner otherwise entitled to relief for infringement or contributory infringement of a patent shall be denied relief or deemed guilty of misuse or illegal extension of the patent right by reason of his having done one or more of the following: (1) derived revenue from acts which if performed by another without his consent would constitute contributory infringement of the patent; (2) licensed or authorized another to perform acts which if performed except officers and employees of the Patent Office, a patent without the payment of fees, when the head of a department or agency certifies the invention is used or likely to be used in the public interest and the applicant in his application states that the invention described therein, if patented, may be manufactured and used by or for the Government for governmental purposes without the payment to him of any royalty thereon, which stipulation shall be included in the patent.

## 19 U.S.C.A.

## §1337

(a) *Unfair methods of competition declared unlawful.* Unfair methods of competition and unfair acts in the importation of articles into the United States, or in their sale by the owner, importer, consignee, or agent of either, the effect or tendency of which is to destroy or substantially injure an industry, efficiently and economically operated, in the United States, or to prevent the establishment of such an industry, or to restrain or monopolize trade and commerce in the United States, are hereby declared unlawful, and when found by the President to exist shall be dealt with, in addition to any other provisions of law, as hereinafter provided.

. . .

(e) *Exclusion of articles from entry.* Whenever the existence of any such unfair method or act shall be established to the satisfaction of the President he shall direct that the articles concerned in such unfair methods or acts, imported by any person violating the provisions of this chapter, shall be excluded from entry into the United States, and upon information of such action by the President, the Secretary of the Treasury shall, through the proper officers, refuse such entry. The decision of the President shall be conclusive.

. . .



